

Remarks

Reconsideration of this Application is respectfully requested.

By this Amendment, the Specification, at paragraph 89 as originally filed, is sought to be amended. Support for this amendment is found throughout the application as filed. For example, reference is made to mutant PS1 polypeptides in the Abstract. It is believed that this change introduces no new matter, and its entry is respectfully requested.

Additionally, claim 12 is sought to be amended and new claim 16 is sought to be entered. Claims 1-11 and 13-15 have already been withdrawn without prejudice to or disclaimer of the subject matter therein. Support for the amendment in claim 12 can be found, *inter alia*, in the claim as originally filed. Support for claim 16 can be found at page 7, lines 3-10 and page 20, lines 11-16 of the specification and in original claim 12. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections Under 35 U.S.C. § 112

In the Office Action, at page 2, the Examiner rejected claim 12 under 35 U.S.C. § 112, first paragraph "as containing subject matter which was not described in the specification in such a way to reasonably convey...that the inventor(s),..., had possession of the claimed invention." Applicants respectfully traverse this rejection.

Specifically, the Examiner asserted that "not a single specific epitope-bearing portion is described." Applicants disagree. Solely in an effort to expedite prosecution, and without acquiescing with the propriety of the rejection, Applicants have amended claim 12 to remove the language referring to "the amino acid sequence of an epitope-bearing portion...", thus rendering the rejection of claim 12 under 35 U.S.C. § 112, first paragraph moot.

In view of the foregoing amendment and explanation, Applicants respectfully request that the rejection of claim 12 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Rejection of Claim 12 Under 35 U.S.C. § 102(e) as Anticipated by St. George-Hyslop et al. Must be Withdrawn

In the Office Action at pages 3-4, claim 12 was rejected under 35 U.S.C. § 102(e) as being anticipated by St. George-Hyslop *et al.* (United States patent no. 6,210,919 B1; hereinafter "St. George-Hyslop"). Applicants respectfully traverse this rejection. Applicants have amended Claim 12, thus rendering this rejection moot. As such, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 102(e).

A claimed invention is anticipated under 35 U.S.C. § 102 only if there is "[d]isclosure in a single piece of prior art of each and every limitation of a claimed invention." *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20, 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). By the Examiner's own admission at page 3 of the Office Action, "St. George-Hyslop *et al.* teach the PS1 polypeptide of SEQ ID NO: 30, *except* for a substitution at positions #s 264 & 315." Thus, St. George-Hyslop fails to

disclose at least the specific amino acids residues at the specific amino acid positions, i.e., a leucine at amino acid position 264 of SEQ ID NO: 30, that are recited in the currently pending claims. As such, St. George-Hyslop cannot and does not anticipate the currently pending claims.

For at least the forgoing reason, Applicants respectfully submit that St. George-Hyslop does not disclose the invention as presently claimed. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C § 102(e).

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Upon allowance of claims 12 and 16, Applicants request rejoinder of claim 11, directed to a method of making the polypeptide. It is the Applicants' position that if the polypeptides of claims 12 and 16 are allowable, then the method of claim 11 should likewise be allowable. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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